

Appl. No. 10/810,347
Amdt. dated July 11, 2007
Reply to Office action of April 11, 2007

REMARKS/ARGUMENTS

Claims 1 and 6-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (USPN D241958) in view of Huffman (USPN 5215307) and Piccini (USPN 4378113) further in view of Spivey (USPN 4272077). The Applicant is concurrently filing a Notice of Appeal.

The claims as amended and presented are believed to distinguish structurally over the art of record and to be unobvious over that art, whether that art is considered singly or in combination. The law of obviousness has been clear for generations: "The mere fact that elements of [an invention] may be found in various [references] does not necessarily negate invention." *In re McKenna*, 40 C.C.P.A. 937, 203 F.2d 717, 721, 97 U.S.P.Q. (BNA) 348, 351 (CCPA 1953). It is respectfully suggested that the Examiner here improperly has constructed a rejection with hindsight based merely on the road map provided by Applicant's specification. As the Federal Circuit has admonished, "virtually all [inventions] are combinations of old elements." What the Examiner apparently has attempted to do is to find every individual element of the claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negated patentability, very few patents would ever issue.

To counter this propensity to construct an obviousness rejection, the suggestion to combine the art stands as a safeguard against hindsight analysis and rote application

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of the legal test for obviousness. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." M.P.E.P §2143.01(l) (Citations omitted)

The recent *KSR* case (*KSR Int'l. Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007) is not believed to have altered the requirements. See U.S.P.T.O MEMORANDUM attached as Exhibit 1.

Viewed in this light, the Examiner's rejection is clearly erroneous. Smith (USPN D241958) is particularly deficient. As a design patent, nothing is known about the device except for the way the device looks. Even then, the design element appears to be a V shaped structure shown in Figure 1. Applicant calls the Examiner's attention to the fact that the title of the design is "Golf Swing Practice Club." Nothing in that title even vaguely suggests a conditioning device in the context of Applicant's invention. But the Examiner has made Smith the primary reference. If the Examiner has some knowledge of the Smith device, Applicant respectfully requests that the Examiner make that knowledge of record by affidavit as set forth in 37 CFR 1.104(d)(2); M.P.E.P. § 707.

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Hoffman (USPN 5,215,307) cannot properly be combined with Smith, if Smith, for the purposes of argument, has some meaning not evident on the face of the design as applied by the Examiner, because Hoffman specifically teaches away from Smith. Smith shows a structure at one end (and because Smith is a design patent, it is not clear what that structure is). Assuming for the sake of argument that the structure is some form of weight, the combination being made by the Examiner is improper. The problem Hoffman allegedly solves is, as stated at Column 1, lines 19-22, "What is needed is a weighted exercise device that will allow the user to practice the specific swing of a given sport such as golf, tennis or baseball but not affect the balance of the user while performing the exercise." The two concepts are mutually exclusive, and the combination made by the Examiner is respectfully suggested to be erroneous.

Piccini (USPN 4, 378,113) likewise is deficient. First, it also teaches away from the claimed invention in that it has variable weights. Second, it is exercise specific, stating at column 1, 9-11, that "This invention relates to warm-up exercises for athletes and more particularly to wrist warm-up exercises for baseball players." Applicant's Claim 1 as presently presented also is exercise specific, but the exercise specific structure required by the claims (and not shown in the art) applies to the forearms, not the wrists. That is not a distinction without a difference, in that in many sports, it is the forearm that requires strengthening.

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Spivey (UPSN 4272077) is even more remote, and truly demonstrates that the Examiner has used Applicant's specification to combine unrelated pieces of prior art, having little or no relationship to Applicant's structural combination to fashion an improper rejection. Spivey is a "Golf Club Putter Grip." The whole purpose of Spivey is to improve the user's putting by "minimizing putter jerks or yips by preventing the non-dominant hand from overriding the dominant hand." (See Abstract). Spivey is not concerned with any of the problems overcome by Applicant's device or the structural combination as a whole of Applicant's claims. 35 U.S.C 103(a) still requires "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." (Emphasis supplied). It is respectively suggested that the Examiner has only paid lip service to the requirement concerning the "subject matter as a whole" language of the statute. Nothing in the art of record shows describes or even vaguely intimates the "subject matter as a whole" of Applicant's structural combination set forth in the claims. Rather, apparently using Applicant's specification as a guide, the Examiner has improperly constructed the rejection element by element.

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Entrance of the Amendment, withdrawal of the rejection and passage of the case
to issue are respectfully requested.

Respectfully submitted,

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